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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,186	11/12/2003	Benoit Glazer	34728	6129

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AKERMAN SENTERFITT
P O BOX 231
ORLANDO, FL 32802-0231

EXAMINER

LOCKETT, KIMBERLY R

ART UNIT	PAPER NUMBER
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2837

DATE MAILED: 05/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/706,186

Applicant(s)

GLAZER, BENOIT

Examiner

Kim R. Lockett

Art Unit

2837

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-10 and 13-20, drawn to a brass wind instrument, classified in class 84, subclass 380r
 - II. Claims 11 and 12, drawn to a mouthpiece, classified in class 84, subclass 383r.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the mouthpiece has separate utility.
3. During a telephone conversation with Jon Gibbs on 4/12/06 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-10 and 13-20. Affirmation of this election must be made by applicant in replying to this Office action. Claims 11 and 12 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Drawings

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "threaded region at the top portion of said valve casing" and the "valve pistons" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

5. Claims 1-10, 14, and 15 are objected to because of the following informalities:

The phrase "in communication said exit tube" is not clear. The phrase "said parts" appears to be misspelled. Appropriate correction is required.

Specification

6. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification fails to disclose the "shank" and the "guider" .

Claim Rejections - 35 USC § 112

7. Claims 5, 8, and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The "shank" and the "guider" although recited in the claims are not described in the specification.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-4, 11, 12, and 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chesko in view of JP02004354492A.

Chesko discloses the use of a brass-wind instrument comprising a gapless mouthpiece; a lead pipe(14) in fluid communication with the mouthpiece(12) further comprising a plurality of valves (16) dispersed in the valve chambers; a plurality of elongated tubes(24) in fluid communication and having an unimpeded air column therein; an exit tube; and a bell (20) in fluid communication with the exit tube (see figure 3).

Chesko does not disclose the specific use of a monoblock or a single piece body.

JP02004354492A discloses the use of a brass-wind instrument comprising a single piece monoblock valve body(15) in fluid in communication with a pipe/tube(see figure) at an angle substantially perpendicular to valve chambers and a plurality of valve cylinders (11,12) for receiving valves and ports.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device as disclosed by Chesko with the monoblock as disclosed by JP02004354492A in order to facilitate valve operation.

10. Claims 9, 10, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chesko in view of JP02004354492A and Greenleaf.

Chesko discloses the use of a brass-wind instrument comprising a gapless-mouthpiece; a lead pipe(14) in fluid communication with the mouthpiece(12) further comprising a plurality of valves (16) dispersed in the valve chambers; a plurality of elongated tubes(24) in fluid communication and having an unimpeded air column therein; an exit tube; and a bell (20) in fluid communication with the exit tube (see figure 3).

Chesko does not disclose the specific use of a monoblock or a single piece body.

JP02004354492A discloses the use of a brass-wind instrument comprising a single piece monoblock valve body(15) in fluid in communication with a pipe/tube(see figure) at an angle substantially perpendicular to valve chambers and a plurality of valve cylinders (11,12) for receiving valves and ports.

Chesko and JP02004354492A do not disclose the use of a valve casing with a threaded region at the top to receive a valve cover and retain a valve piston.

Greenleaf discloses the use of a valve casing with a threaded region at the top to receive a valve cover and retain a valve piston(14) (see figure 5).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device as disclosed by Chesko with the monoblock as disclosed by JP02004354492A and the cap as disclosed by Greenleaf in order to eliminate rattling.


11. Claims 5-8 and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. Papers related to this application may be submitted to Group 2800 by facsimile transmission. Papers should be faxed to Group 2800 via the PTO 2800 Fax Center at 703-872-9306.

For assistance in **Patent procedure, fees or general Patent questions** calls should be directed to the **Patents Assistance Center (PAC)** whose telephone number is **800-786-9199**. Assistance is also available on the Internet at www.uspto.gov.

Any inquiry concerning **this communication or earlier communications from the examiner** should be directed to **Kim Lockett whose telephone number is (703) 308-7615, after 2/3/04 my new number will be (571) 272-2067**. The examiner can normally be reached on Monday through Friday from 7:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Bradley can be reached on (571) 272-2800 ext. 33.


KIMBERLY LOCKETT
PRIMARY EXAMINER